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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,094	04/10/2001	Mark Alan Sturza	HMD2000-1-CIPB	8875
7590		11/30/2004	EXAMINER	
Anglin & Giaccherini		DUONG, FRANK		
Post Office Box 1146		ART UNIT		
Carmel Valley, CA 93924		PAPER NUMBER		
		2666		

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/833,094

Applicant(s)

STURZA ET AL.

Examiner

Frank Duong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02/07&12/02/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is a response to communications dated 04/01/01. Claims 1-28 are pending in the application.

Information Disclosure Statement

2. The information disclosure statements filed 12/02/02 and 02/07/02 comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. They have been considered and placed in the application file.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-28 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-28 of copending Application No. 09/948,021. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 20-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-21 of copending Application No. 10/094,943. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the below rationales:

Instant application claim 20 calls for "*an apparatus comprising: transmission means for transmitting digitized **packets of data** over a network means for communicating said **packets of data**; said **data** being transmitted to a plurality of authorized users; said transmission means including a gateway means; said transmission means further including a relay means for receiving said plurality of digitized **packets of data** from said gateway means and for retransmitting during a time period when the total communications capacity of said relay means is not fully used; a receiver means for collecting said plurality of digitized **packets of data** which are transmitted from said transmission means; said receiver means including a storage means for accumulating said plurality of digitized **packets of data***

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*incrementally over an extended period of time; and retrieving and using said plurality of digitized **packets of data** after a generally full program has been accumulated".*

Copending application claim 13 calls for "*an apparatus comprising: transmission means for transmitting digitized **packets of software** over a network means for communicating said **packets of software**; said **software** being transmitted to a plurality of authorized users; said transmission means including a gateway means; said transmission means further including a relay means for receiving said plurality of digitized **packets of software** from said gateway means and for retransmitting during a time period when the total communications capacity of said relay means is not fully used; a receiver means for collecting said plurality of digitized packets of software which are transmitted from said transmission means; said receiver means including a storage means for accumulating said plurality of digitized **packets of software** incrementally over an extended period of time; and retrieving and using said plurality of digitized **packets of software** after a generally full program has been accumulated".*

A comparison between claims 20 of the instant application and claim 13 of the copending application renders a replacement of the term "data" with the term "software" or a mere difference in the wording. Such difference is deemed to be an obvious field expedient.

Dependent claims 21-28 of the instant application are provisionally rejected over claims 14-21 of the copending application for the same rationales discussed above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Aristides et al (USP 5,657,072) (hereinafter "Aristides").

Regarding **claim 1**, in accordance with Aristides reference entirety, Aristides discloses a method comprising the steps of:

utilizing the excess capacity of a network by conveying data over said network during a period of less than maximum usage (*Fig. 4; steps 100-102 and col. 7, line 50 to col. 8, line 11*);

receiving said data during said period of less than maximum usage (*Fig. 4; steps 102-104 and col. 7, line 59 to col. 8, line 24*);

accumulating said data over an extended period of time (*Fig. 4; step 104 and col. 8, lines 12-24*); and

retrieving said data for on-demand use at a time after said extended period of time (*col. 8, lines 13-24*).

Regarding **claim 2**, in addition to features recited in base claim 1 (see rationales discussed above), Aristides further discloses in which said network includes a satellite (*col. 4, line 1*).

Regarding **claims 3-8**, in addition to features recited in base claim 2 (see rationales discussed above), Aristides further discloses satellite systems (at col. 4, line 1) encompassing the claimed satellite systems as recited.

Regarding **claim 9**, in addition to features recited in base claim 2 (see rationales discussed above), Aristides further discloses in which said network includes a terrestrial wired network (see Fig. 1 and col. 3, line 66 to col. 4, line 14).

Regarding **claim 10**, in addition to features recited in base claim 2 (see rationales discussed above), Aristides further discloses in which said network includes a terrestrial wireless network (*see Fig. 1 and col. 3, line 66 to col. 4, line 14*).

Regarding **claim 11**, in addition to features recited in base claim 10 (see rationales discussed above), Aristides further discloses transmitting said data by television broadcast stations on existing channels; said data being inserted into picture scan lines (*col. 2, line 62 and thereafter*).

Regarding **claim 12**, in addition to features recited in base claim 10 (see rationales discussed above), Aristides further discloses transmitting said data by television broadcast stations on existing channels; said data being inserted into scan lines corresponding to a Vertical Blanking Interval (VBI) (*col. 2, line 62 and thereafter*).

Regarding **claim 13**, in addition to features recited in base claim 10 (see rationales discussed above), Aristides further discloses transmitting said data by television broadcast stations on existing channels; said data being inserted into

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subcarriers in a composite baseband of television signals, of zero to 120 kilohertz (see *Fig. 1 and col. 3, line 66 to col. 4, line 14*).

Regarding **claim 14**, in addition to features recited in base claim 10 (see rationales discussed above), Aristides further discloses transmitting said data by television broadcast stations on existing channels; said data being inserted into other signals in a composite base band of television signals, of zero to 120 kilohertz (see *Fig. 1 and col. 3, line 66 to col. 4, line 14*).

Regarding **claim 15**, in addition to features recited in base claim 10 (see rationales discussed above), Aristides further discloses transmitting said data by an AM radio broadcast station on an existing channel (see *Fig. 1 and col. 3, line 66 to col. 4, line 14*).

Regarding **claim 16**, in addition to features recited in base claim 10 (see rationales discussed above), Aristides further discloses transmitting said data by a FM radio broadcasting station on an existing channel (see *Fig. 1 and col. 3, line 66 to col. 4, line 14*).

Regarding **claim 17**, in addition to features recited in base claim 10 (see rationales discussed above), Aristides further discloses transmitting said data by an AM radio broadcast station on an existing channel includes the step of transmitting said data by signals not audible on ordinary consumer receivers (see *Fig. 1 and col. 3, line 66 to col. 4, line 14*).

Regarding **claim 18**, in addition to features recited in base claim 15 (see rationales discussed above), Aristides further discloses in which the step of

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transmitting said data by an AM radio broadcast station on an existing channel includes the step of modulating a sub carrier at a center frequency of said channel (*not shown; inherent in the system disclosed at col. 3, line 66 to col. 4, line 14*).

Regarding **claim 19**, in addition to features recited in base claim 16 (see rationales discussed above), Aristides further discloses in which the step of transmitting said data by an FM radio broadcast station on an existing channel includes the step of modulating a subcarrier at a center frequency of said channel (*not shown; inherent in the system disclosed at col. 3, line 66 to col. 4, line 14*).

Regarding **claim 20**, in accordance with Aristides reference entirety, Aristides shows an apparatus (*Fig. 1; element 20 and col. 3, line 45 to col. 6, line 46*) comprising:

transmission means (*Fig. 1; element 22*) for transmitting digitized packets of data over a network means (*Fig. 1*) for communicating said packets of data; said data being transmitted to a plurality of authorized users (*Fig. 1; elements 24a-24d*); said transmission means including a gateway means (*Fig. 1; elements 60-62*); said transmission means further including a relay means (*Fig. 1; elements 68 and 70*) for receiving said plurality of digitized packets of data from said gateway means (*Fig. 1; elements 60 and 62*) and for retransmitting during a time period when the total communications capacity of said relay means is not fully used (*col. 5, line 40 to col. 6, line 36*);

a receiver means (*Fig. 5 and col. 8, line 24 to col. 9, line 4*) for collecting said plurality of digitized packets of data which are transmitted from said transmission

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means (*Fig. 1; element 22*); said receiver means (*Fig. 5*) a storage means (*Fig. 5; element 206*) for accumulating said plurality of digitized packets of data incrementally over an extended period of time; and retrieving and using said plurality of digitized packets of data after a generally full program has been accumulated (*col. 8, lines 36-62*).

Regarding **claim 21**, in addition to features recited in base claim 20 (see rationales discussed above), Aristides further discloses in which said transmission means includes television broadcast stations on existing channels; said data being inserted into picture scan lines (*col. 2, line 62 and thereafter*).

Regarding **claim 22**, in addition to features recited in base claim 20 (see rationales discussed above), Aristides further discloses in which said transmission means include television broadcast stations on existing channels; said data being inserted into video scan lines corresponding to a Vertical Blanking Interval (VBI) (*col. 2, line 62 and thereafter*).

Regarding **claim 23**, in addition to features recited in base claim 20 (see rationales discussed above), Aristides further discloses in which said transmission means includes television broadcast stations transmitting on an existing channel; said data being inserted into a subcarrier in a composite baseband of television signals, of zero to 120 kilohertz (*see Fig. 1 and col. 3, line 66 to col. 4, line 14*).

Regarding **claim 24**, in addition to features recited in base claim 20 (see rationales discussed above), Aristides further discloses in which said transmission means includes an AM radio broadcast station transmitting on an existing channel.

Regarding **claim 25**, in addition to features recited in base claim 20 (see rationales discussed above), Aristides further discloses in which said transmission means includes a FM radio broadcasting station transmitting on an existing channel.

Regarding **claim 26**, in addition to features recited in base claim 24 (see rationales discussed above), Aristides further in which said AM radio broadcast station transmits said data by signals not audible on ordinary consumer receivers (*not shown; inherent in the system disclosed at col. 3, line 66 to col. 4, line 14*).

Regarding **claim 27**, in addition to features recited in base claim 25 (see rationales discussed above), Aristides further discloses in which said FM radio broadcast station transmits said data by modulating a subcarrier at a center frequency of said channel (*not shown; inherent in the system disclosed at col. 3, line 66 to col. 4, line 14*).

Regarding **claim 28**, in addition to features recited in base claim 25 (see rationales discussed above), Aristides further discloses in which said FM radio broadcast station transmits said data by modulating a subcarrier at a center frequency of said channel (*not shown; inherent in the system disclosed at col. 3, line 66 to col. 4, line 14*).

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Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McMullan, Jr. et al. (USP 5,654,746).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Duong whose telephone number is (571) 272-3164. The examiner can normally be reached on 7:00AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on (571) 272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frank Duong
Examiner
Art Unit 2666

November 26, 2004